

REMARKS

The Office Action of December 11, 2007 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Inconsistencies in Office Action

Turning now, to the office action, Applicants first note that the Office Action Summary provided with the Office Action is inconsistent with the Office Action. The Summary sheet indicates that claims are objected to, but no claims are listed, and the Summary indicates that the Specification is objected to, but again no objections are set forth. Applicants assume, therefore, that the Summary is incorrect with regard to these two inconsistencies and that the specification and claims are not objected to. In the event that there are objections, Applicants respectfully request that the Examiner set them forth in a subsequent, non-final action, and that Applicants be permitted to submit remarks and amendments in response thereto.

Applicants further note that the Office Action, at page 2, indicates that "Claims 1-6, 1-13 and 15 are rejected under..." Applicants, based upon the detailed discussion of the rejection believe that the rejection was intended to apply to claims 1-6, 11-13 and 15, and have prepared the following response in accordance therewith.

Claim Amendments

It is respectfully noted that claims 1 and 6 have been amended.

Office Action

Claims 1 – 14 were rejected under 35 USC §112, second paragraph, as being indefinite. Claims 2-5 and 7-14 were rejected under 35 USC §112, second paragraph, as depending on rejected claims 1 or 6. Claims 1-6, 11-13 and 15 were rejected under 35 USC §102(b) as being anticipated by Tagami et al., US Patent No. 5,237,425 (hereinafter "Tagami"). Claims 14 and 16-19 were rejected under 35 USC §103(a) as being unpatentable over Tagami in view of Draaisma, US Pub. No. 2003/0227638 A1 (hereinafter "Draaisma").

Arguments in Traversal of Rejections

Claims 1 – 14 were rejected under 35 USC §112, second paragraph, as being indefinite. With respect to the rejection of independent claims 1 and 6, Applicants respectfully urge that the clarifying amendment proposed for claims 1 and 6 overcomes the rejection. In particular, while Applicants do not believe that indefiniteness arises from the term noted by the Examiner, Applicants have nonetheless deleted the term “primary” from the preamble in both independent claims 1 and 6 by amendment. In view of the amendments to claims 1 and 6, Applicants respectfully submit that the rejection is overcome and seek acknowledgement thereof in a subsequent communication.

In view of the amendments to claims 1 and 6, claims dependent therefrom are also believed to overcome the rejection under 35 USC §112, second paragraph. In particular, claims 7-12, not having had any further rejections set forth are believed to be in condition for allowance as well.

Claims 1-6, 11-13 and 15 were rejected under 35 USC §102(b) as being anticipated by Tagami et al., US Patent No. 5,237,425 (hereinafter “Tagami”). Considering, first, independent claim 1, Applicants respectfully submit that the rejection fails to set forth a *prima facie* case of anticipation by teaching all the limitations recited in claim 1. In setting forth the rejection of claim 1, the Examiner has identified a number of references to Tagami, originally identified by Applicants and even referred to in the Specification. As set forth, Applicants urge that Tagami generally discloses a compiler for producing, from an Ink Source Language, a catalog of colors using two colorants (e.g., black plus highlight color) for use in a printer.

Although there are a number of recited elements that are not taught, Applicants particularly note that Tagami does not teach “based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output,” as set forth in claim 1. The rejection urges that such a limitation is taught at col. 12, lines 38-40, col. 14, lines 16-20 and Fig. 26, yet Applicants are unable to identify where any suggestion of an intermediate output representing the combination of the primary and secondary colors, based upon the rendering characteristics, is disclosed. Of further note is the fact that the term

"intermediate output" does not even appear in Tagami, let alone in the cited section. How then can Tagami anticipate such a limitation?

Applicants also urge that the rejection sets forth conflicting interpretations of Tagami, for example indicating that col. 6, line 54 through col. 7, line 13 teaches "determining ... a rendering characteristic for each of the primary color and the secondary color" and then that the same portion teaches the limitation described above. What is it that Tagami teaches in the cited section? Tagami teaches the SCNSET (screen set) and other definitions including pattern, color and texture. There is simply no teaching of the limitations set forth, and at best the cited section includes reference to the words such as patterns, texture and screens in a context that appears to be different than that set forth by claim 1.

Furthermore, Applicants urge that Tagami also fails to anticipate "using a second function to generate the output data representing a single color defined in the full color space." The rejection urged that col. 13, lines 36-39 provided support for such a limitation, but Applicants find no such support in a brief reference to Fig. 26 that is described as "a pictorial view of the relationship between screens, colors, patterns and textures. Applicants question what the Examiner relies upon in support of the recited second function in claim 1. In view of the several failures noted, among others, Applicants respectfully traverse the rejection of claim 1 and request withdrawal thereof.

With respect to independent claim 6, the same sections of Tagami are used by the Examiner to support this rejection. However, not only does Tagami fail to disclose those limitations that are similar to claim 1, as argued above, but independent claim 6 further requires analysis of a screen characteristic value in relation to generating the intermediate output. Once again, Applicants respectfully urge that Tagami fails to teach the limitation of "if the lesser value screen characteristic is zero, generating an intermediate output that is a function of only one of the primary and secondary colors, otherwise, generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate outputs include a highlight color, a highlight color percentage and a black percentage" as set forth in claim 6. For this and similar reasons relative to limitations found in claim 1, Applicants respectfully traverse the rejection of claim 6 as well.

Considering the dependent claims rejected under the same basis, for the sake of brevity specific arguments in support of patentability are not set forth, but such claims are urged as allowable for the reasons set forth above relative to the independent claims from which they depend. Applicants reserve the opportunity, however, to further argue the merits of dependent claims 2-5 and 11-13 in the event the rejection is maintained.

Considering the rejection of claim 15, although claim 15 is not identical to claims 1 or 6, several limitations therein are also not found in Tagami and examples of those were set forth above. In particular, claim 15 requires determining an equivalent color for each input color using a first function and then determining a screen characteristic, where the screen characteristic is evaluated (if zero) to determine if an intermediate output is to be generated in one manner versus another manner (a generalization believed consistent with the limitations of claims 15). Not only is no intermediate output disclosed by Tagami, as previously noted, but Applicants do not believe the Examiner has demonstrated where the screen characteristic is used to control the manner in which an intermediate output is produced. Accordingly, Tagami cannot anticipate claim 15, and Applicants respectfully request that the rejection of claim 15 be withdrawn.

Claims 14 and 16-19 were rejected under 35 USC §103(a) as being unpatentable over Tagami in view of Draaisma, US Pub. No. 2003/0227638 A1 (hereinafter "Draaisma"). Claims 14 and 16-19 are all dependent from the independent claims discussed above and Applicants respectfully refer to the arguments in traversal of the rejection based upon Tagami as incorporated herein. In addition to the distinctions noted relative to Tagami, those and additional limitations of the claims are not believed to be fulfilled by the teachings of Draaisma. Draaisma also fails to teach what has been alleged as the basis for the rejection. Claims 14 and 16 require that the output be represented in an extensible markup language schema. While Draaisma does teach XML as one of a number of structured formats for use with images, Applicants respectfully submit that this does not rise to the level of teaching the limitations of claims 14 and 16. Accordingly, the rejection is respectfully traversed.

With respect to claims 17, 18 and 19, these claims are believed to be allowable for the reasons set forth relative to independent claim 15 above. In the event the

rejection is maintained, Applicants reserve the opportunity to provide further arguments in support of the patentability of dependent claims 17 through 19.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 24-0037 for Xerox Corporation

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

A handwritten signature in dark ink, appearing to be 'DCB', followed by a long horizontal line.

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